

REMARKS

Claims 1-17 are pending in the application. Claims 1, 10, and 15 are independent.

Drawings

In papers filed herewith, Applicants have submitted Formal Drawings that correct the informalities indicated on the Notice of Draftsperson's Patent Drawing Review. A courtesy copy is enclosed for the Examiner.

Objection to Claims 2, 13, and 16

In the Office Action, the Examiner objected to claims 2, 13, and 16. In the present Response, Applicants have amended claims 2, 13, and 16 to accommodate the Examiner's objection. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the objections.

Rejection of Claims 1-17 Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner rejected claims 1-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,612,963 to Koenemann et al. ("Koenemann"). A claim is anticipated only if each and every element of the claim is found in a reference. (M.P.E.P. § 2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236 (Fed. Cir. 1989)). Applicants respectfully traverse the rejection.

Amended Claim 1 recites in pertinent part "a data download circuit to download each random weight determining signal to the weight generator circuit in synchronization with the weight generator circuit providing the corresponding pseudo-random weighted input bit to a scan chain." In contrast, Koenemann fails to teach or disclose this embodiment of the claimed invention. As such, Koenemann fails to anticipate claim 1 and claim 1 is patentable over Koenemann. Claims 2-9 properly depend from claim 1 and are thus patentable as well. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejections to claims 1-9.

Original Claim 10 recites in pertinent part “downloading to the weight generating unit the corresponding data field from the memory in synchronization with the weight generating unit providing a corresponding bit of the bit stream.” In contrast, Koenemann fails to teach or disclose this embodiment of the claimed invention. As such, Koenemann fails to anticipate claim 10 and claim 10 is patentable over Koenemann. Claims 11-14 properly depend from claim 10 and are thus patentable as well. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejections to claims 10-14.

Original Claim 15 recites in pertinent part “each said weight generator circuit is to determine a bit of a provided test data bit stream weight depending upon a corresponding stored control signal.” In contrast, Koenemann fails to teach or disclose this embodiment of the claimed invention. As such, Koenemann fails to anticipate claim 15 and claim 15 is patentable over Koenemann. Claims 16-17 properly depend from claim 15 and are thus patentable as well. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejections to claims 15-17.

Rejection of Claims 1-5, 10-13, and 15-17 Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner rejected claims 1-5, 10-13, and 15-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,612,963 to Motika et al. (“Motika”). Applicants respectfully traverse the rejection.

Amended Claim 1 recites in pertinent part “a data download circuit to download each random weight determining signal to the weight generator circuit in synchronization with the weight generator circuit providing the corresponding pseudo-random weighted input bit to a scan chain.” In contrast, Motika fails to teach or disclose this embodiment of the claimed invention. As such, Motika fails to anticipate claim 1 and claim 1 is patentable over Motika. Claims 2-5 properly depend from claim 1 and are thus patentable as well. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejections to claims 1-5.

Original Claim 10 recites in pertinent part “downloading to the weight generating unit the corresponding data field from the memory in synchronization with the weight generating unit providing a corresponding bit of the bit stream.” In contrast, Motika fails to teach or disclose this embodiment of the claimed invention. As such, Motika fails to anticipate claim 10 and claim 10 is patentable over Motika. Claims 11-13 properly depend from claim 10 and are thus patentable as well. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejections to claims 10-13.

Original Claim 15 recites in pertinent part “each said weight generator circuit is to determine a bit of a provided test data bit stream weight depending upon a corresponding stored control signal.” In contrast, Motika fails to teach or disclose this embodiment of the claimed invention. As such, Motika fails to anticipate claim 15 and claim 15 is patentable over Motika. Claims 16-17 properly depend from claim 15 and are thus patentable as well. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejections to claims 15-17.

Because the Examiner has not made out a *prima facie* case of anticipation with respect to claims 1-17, Applicants respectfully submit that claims 1-17 are patentable over the cited references. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejections to claims 1-17.

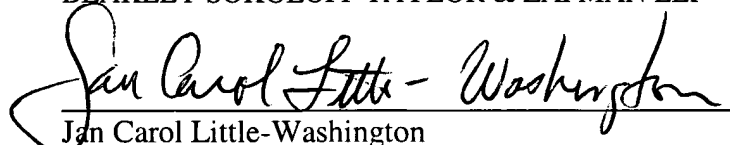
CONCLUSION

Applicants respectfully submit that all grounds for objection and rejection have been properly accommodated or traversed and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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Date: 11/25/2003


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